GAU 1761

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. Of: OWADES

Serial No.: 09/833,924

Filed: April 12, 2001

For: PROCESS FOR PRODUCING A MALT BEVERAGE

Group: 1761

Examiner: CURTIS EDWARD SHERRER DOCKET: OW-20

The Assistant Commissioner of Patents
Washington, D.C. 20231

AMENDMENT A

Dear Sir:

This Amendment is being filed in response to the Official Action mailed July 23, 2002. Provisional election is hereby made, with traverse, to prosecute the invention of Group I, comprising claims 1-7.[1]

The Action states, ". . . the product as claimed can be made by another and materially different process, e.g. the juniper berry oil can be added during mashing or fermentation." However, the Examiner's suggestion is directly contrary to the specific teachings in Applicant's specification that the juniper berry oil is added "following completion of the brewing process, i.e., following fermentation and before packaging." (See page 5, lines 14-15.) Needless to say, the Examiner should not ignore contraindications in the specification in order to make out a case for restriction.

In requiring restriction, the Examiner also notes the inventions are classified in different classes and sub-classes, thus alluding to the fact that the inventions would involve divergent

[1] The Examiner includes claim 8 in both Groups I and II. Claim 8 is a product by process claim and is directly linked to claim 1. Accordingly, it is believed that at a minimum claim 8 should be included in Group I, i.e., with claims 1-7.

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

fields of search. However, as the Examiner is well aware, such a factor per se is not a basis for determining distinctiveness in accordance with MPEP 806.

Furthermore, it is respectfully submitted that there is nothing in 35 USC § 121 that gives the Patent Office the authority to require restriction between different statutory classes of claims unless the claims cover "independent and distinct inventions." It is respectfully submitted that the statutory requirements not having been met here vis-à-vis Groups I and II respectively, the Examiner should withdraw the requirement for restriction and provide Applicant with an action on the merits of the withdrawn claims.

It should be noted that restriction requirements as prescribed by 35 USC § 121 are discretionary with the Examiner, and in view of the remarks above, the restriction requirement should be withdrawn.

In summary, therefore, all of the claims are believed to be directed to a single invention. However, so as to be fully responsive, Applicant provisionally elects to prosecute Group I, i.e., claims 1-7, and it is requested that, without further action thereon, the remaining claims be retained in this Application pending disposition of the Application, and for possible filing of a divisional application.

An action on the merits is respectfully requested.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our deposit account number 08-1391.

Respectfully submitted,

Norman P. Soloway
Attorney for Applicant
Reg. No. 24,315

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231 on August 6, 2002, at Tucson, Arizona.

By Diana Carr

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701
TEL. 520.882.7623
FAX. 520.882.7643

175 CANAL STREET
MANCHESTER, NH 03101
TEL. 603.668.1400
FAX. 603.668.8567